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PATENT

Attorney Docket No. 23853A

Bet 10-31-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Alan DRIZEN et al.

Examiner: M. Haghighatian

Serial No.: 09/986,183

Group Art Unit: 1626

Filed: November 7, 2001

For: **TOPICAL DRUG PREPARATIONS**

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action dated August 20, 2002. The one-month shortened statutory period set for response expired September 20, 2002. Therefore, a one-month Extension of Time under 37 C.F.R. § 1.136 is concomitantly filed, and this response is thereby filed within the time period set by the Examiner.

SUMMARY OF RESTRICTION REQUIREMENT

The Examiner has required applicant under 35 U.S.C. 121 to elect a single Group from the following:

Group I: Claims 45-56, drawn to a composition, classified in class 424, subclass 484.

Group II: Claims 57-71, drawn to a method for treating classified in class 424, subclass 484.

As the basis for this restriction requirement, the Examiner contends that the inventions are distinct, each from the other, for the following reasons:

> Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h)). In the instant case the composition of invention I can be used to treat various skin disorders. The method of treating dermatological conditions can be accomplished applying various topical dermotological compositions and preparations.

ELECTION

Applicant elects: Group II: Claims 57-71, drawn to a method for treating, classified in class 424, subclass 484.

TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement.

The Examiner has given a number of reasons for the requirement, however, at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims.

Furthermore, the restriction requirement is improper because

it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required. (M.P.E.P. § 803, Revision 14, November 1992). An examination of all the claims in this application would not pose a serious burden because given the overlapping subject matter of the composition and method claims, examinations of all the invention groups would not pose a serious burden because the searches would be coextensive. Further, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

In light of the foregoing, withdrawal of the restriction requirement is respectfully solicited since the burden of the Examiner is not very great to search all of the groups.

CONCLUSION

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney at the below-listed number and address.

Respectfully submitted,

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